

REMARKS

Claims 1, 3-10, 12 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claims 1, 3 and 8 are independent claims. Claims 4-7, 12 and 13 depend from claim 3, and claim 9 and 10 depend from claim 8. It is respectfully submitted that the independent claims 1, 3 and 8 recite elements of the invention that are not identically shown by the Richards reference, and therefore the Richards reference does not anticipate the subject matter of these claims under the patent law.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

In Re Bond, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), aff'd in part, rev'd in part on other grounds, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate.

Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 33 USPQ 2d 1496, 1498, 1995-1 Trade Cas. (CCH) P 70891 (Fed. Cir. 1995).

Claim 1 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 mounted on the rod. The claim further recites "the forward grip member having a plurality of resilient arms that extend along the rod." Claim 3 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively connected with the rod. Claim 3 further recites "a plurality of resilient arms integrally connected with the forward grip member." Claim 8 also recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively

connected with the rod.” The claim further recites “a plurality of resilient arms operatively connected with the forward grip member.”

Each of the independent claims discussed above recites a forward grip member 82 having a plurality of resilient arms 102.

In the latest anticipation rejection of the independent claims 1, 3, and 8, the rejection now refers to Figure 4 of the Richards reference and interprets the rod 14 of Figure 4 as the rod recited in claims 1, 3, and 8. The rejection further interprets one of the triggers 20 shown in Figure 4 as the forward grip member 82 recited in claims 1, 3, and 8. However, the independent claims 1, 3, and 8 recite the forward grip member as having a plurality of resilient arms.

In viewing Figures 3 and 3A of the Richards reference, it can be seen that each trigger 20 has only one tie arm 20T and only one hook 20H at the distal end of the tie arm (see column 3, lines 25-31 of the Richards reference). What the Richards reference actually does disclose is a plurality of triggers 20, with each trigger having only one tie arm 20T and only one hook 20H at the distal end of the tie arm.

Interpreting the language of the independent claims 1, 3, and 8 consistently with the specification, as is required by the above-cited case law, the Richards reference does not identically show a forward grip member having a plurality of resilient arms, and therefore does not identically show every element of the claimed invention recited in the independent claims 1, 3, and 8, as required for a proper anticipation rejection under the above-cited case law. The Richards reference therefore does not anticipate claims 1, 3-10, 12, and 13 as contended in the rejection of claims 1, 3-10, 12, and 13.

Furthermore, independent claim 1 recites the elongate rod 14 having a distal end 42 that is adapted to be attached to a surgical instrument head, the piston 16 being mounted on the rod adjacent the rod distal end 42, and the plurality of arms having distal ends 92 that operatively engage with the piston 16 whereby manual movement of the arm distal ends 92 radially inwardly moves the piston 16 axially toward the rod distal end 42 and movement of the piston 16 axially away from the rod distal end 42 moves the arm distal ends 92 radially outwardly.

Independent claim 3 also recites the elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms 102 radially outwardly.

Independent claim 8 also recites an elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms radially outwardly.

In the latest anticipation rejection of claims 1, 3, and 8, the rejection now refers to Figure 4 of the Richards reference and interprets the rod 14 as the rod of claim 1. It therefore appears that the forward end 18 of the rod 14 in the Richards reference is interpreted as the claimed rod distal end 42 because the forward end 18 is the end that

is adapted for attachment to a surgical instrument head as recited in the rejected claims. The rejection of claims 1, 3, and 8 also interprets the tie arms 20T as the claimed plurality of resilient arms and contends that the plurality of resilient arms 20T, 20H “operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3],” (quoting from the rejection of independent claim 3). However, this interpretation of what is shown in Fig. 3 and Fig. 4 of the Richards reference is incorrect, and the actual movement of what is interpreted as the claimed resilient arms 20T, 20H and the claimed piston 34 is the opposite of that set forth in the rejected claims.

Referring to Figures 3 and 4 of the Richards reference, Figure 3 shows the piston 34 moved away from the rod distal end 18, and Figure 4 shows the piston 34 moved toward the rod distal end 18. In Figure 3, what is interpreted as the resilient arms 20T, 20H are radially closer to the center axis 26 of the rod than are the resilient arms 20T, 20H shown in Figure 4. Thus, when the resilient arms 20T, 20H of the Richards reference are moved toward the center axis 26 of the rod or radially inwardly, the piston 34 is moved away from the rod distal end as shown in Figure 3, and not toward the rod distal end as claimed. In addition, when what is interpreted as the resilient arms 20T, 20H in the Richards reference are moved away from the rod center axis 26 or radially outwardly as shown in Figure 4, the piston 34 is moved toward the rod distal end 18, and not away from the rod distal end as claimed.

In view of the above, the interpretation of the Richards reference relied on in rejecting the independent claims 1, 3, and 8 is made in error. The Richards instrument operates in an opposite manner to that recited in the rejected independent claims 1, 3, and 8. The Richards reference therefore does not identically show every element of the invention recited in independent claims 1, 3, and 8 as is required for a proper anticipation rejection under the above-cited case law. Interpreting the language of the independent claims 1, 3, and 8 consistent with the specification, as is required by the above-cited case law, the Richards reference does not identically show every element of the claimed invention. The Richards reference therefore does not anticipate claims 1, 3, and 8, and claims 1-14 currently pending in the application are allowable over the prior art.

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